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TO: Examiner Alysia Berman GAU 1619 PHONE: (703) 308-4638 FAX: (703) 872-9307

FROM: Dorene M. Price Estée Lauder Companies PHONE: (631) 531-1194 FAX: (631) 591-1340 744-3594

RE: Response to Final Office Action (Serial No. 09/441,832)

OFFICIAL

CC:

Number of pages including cover sheet: 10

Message

Please see the attached documents in response to final office action.

- Certificate of Transmission
- Amendment Transmittal
- Amendment (4 pp) with Attachment (3 pp)

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JUL 02 2002

CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)Applicant(s): Lawson et al.**GROUP 1000**

Docket No.

98.41US-CPA

Serial No.

09/441,832

Filing Date

November 17, 1999

Examiner

Berman, Alysia

Group Art Unit

1619

Invention: Gel-Type Oil Free Cosmetic**OFFICIAL**I hereby certify that this Cert, Amend Trans, Amend (4 pp) & Attach (3pp)

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Dorene Price

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AMENDMENT TRANSMITTAL LETTER (Large Entity)Applicant(s): **Lawson, et al.**Docket No.
98.41US-CPASerial No.
09/441,832Filing Date
November 17, 1999Examiner
Berman, AlysiaGroup Art Unit
1619Invention: **Gel-Type Oil Free Cosmetic****TO THE ASSISTANT COMMISSIONER FOR PATENTS:**

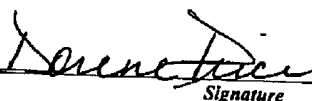
Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	26 -	26 =	0 x	\$18.00	\$0.00
INDEP. CLAIMS	2 -	3 =	0 x	\$84.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$0.00

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- ☒ Any patent application processing fees under 37 CFR 1.17.



Signature

Dated: **July 1, 2002**

Dorene M. Price (Reg. No. 43,018)
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to number
703-872-9307
 to the U.S. P.T.O.

I certify that this document and fee is being deposited on July 1, 2002 *by fax* with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.



Signature of Person Mailing Correspondence

DORENE M. PRICE

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cc:

#15
MP
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N.E

Attorney Docket No.: 98.41CON

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lawson, et al.

Serial No.: 09/441,832

Group Art Unit: 1619

Filed: November 17, 1999

Examiner: Berman, Alysia

For: Gel-Type Oil Free Cosmetic

RESPONSE PURSUANT TO 37 CFR 1.116

Assistant Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

The following is submitted in response to the Final Office Action dated April 1, 2002 in which the Examiner rejects Claims 1 to 3, 7 to 19, 21, 23, 25, and 26. Please consider the accompanying remarks which are believed to either place the application in condition for allowance or in better condition for appeal should the final rejection be maintained. The remarks provided herein could not have been provided earlier as they directly respond to the Examiner's arguments which are raised in the first instance in the final Office Action.

In particular, Claims 1, 7, 15, and 16 are rejected under 35 U.S.C. §112, second paragraph, because the terms "sterol-based" are vague and indefinite. The Examiner finds that a fair review of the specification at page 4, does not provide an exclusive definition of sterol-based surfactants, and further notes that the definition supports the indefiniteness of the term because it recites derivatives without further defining the derivatives. However, there is no support or basis for the Examiner's assertions of exclusivity nor has the Examiner ever produced any authority for this assertion. Applicants have previously cited the requirement that must be met regarding definiteness. There is no requirement that the terms contained in a definition be further defined unless they would not be understood by one of ordinary skill in the art. The Examiner has also failed to provide any reason why one of ordinary skill in the art would not understand the term sterol-based. The term sterol is both defined in the dictionary and is a chemical term that are well known to one of ordinary skill in the art. See Webster's Encyclopedic Unabridged Dictionary of the English Language, p. 1394, Gramercy Books (1989) (copy submitted herewith). The fact that the definition does not expressly state, for example, "sterol-based surfactant/emulsifiers are defined to be . . . " does not prevent one of ordinary skill in the art from

understanding the metes and bounds of this term of art. Thus, Applicants request that this rejection be withdrawn.

In the present Office Action, Claims 1, 2, 7 to 11, 14 to 17, 21, 23, and 25 remain rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,567,420 issued to McEleney et al. ("the '420 reference"). First, Applicants note that it is not clear what the status is with respect to two references previously cited by the Examiner, U.S. Patent No. 5,741,499 ("the '499 reference"), and the U.S. Patent No. 5,393,526 as the Examiner has not commented on these references in the section "Response to Arguments." However, according to the Examiner in response to Applicants' arguments, the '420 disclosure is not limited to its working examples. As previously discussed in Applicants' Response of October 15, 2001, the '420 reference discloses the specific types of gels that are suitable for the alleged invention at column 3, lines 34 to 38 as follows.

For topical use, it is desirable that a CI [color indicator] is dispersed in an emulsion of sunscreen or lotion and applied to the skin. For this purpose, the CIs are intended to be admixed in a pharmacologically acceptable topical carrier such as a gel . . .

Thus, contrary to the Examiner's assertion, the '420 reference, both in the specification and the working examples, discloses that its gels are emulsions, and one of ordinary skill in the art based on the disclosure of the '420 reference would understand that the gels of the '420 reference are emulsions. In addition, the '420 reference fails to disclose a gel composition that has substantially no oil. Even in *In re Mills*, cited by the Examiner in support of this assertion, the polypropylene at issue was expressly provided in the disclosure at issue. *In re Mills*, 176 USPQ 196, 198 (CCPA 1972). Unlike the situation in *Mills*, the '420 disclosure makes no mention of a non-emulsion gel in either its working examples or its specification. The Examiner points out that the '420 reference makes a clear distinction between gels and emulsions. However, this distinction, as the Examiner refers to it, is illogical because the '420 reference has already established in the specification that the gel is an emulsion and it would therefore be redundant to call it a "water-in-oil" or "oil-in-water" gel, or even an emulsion gel for that matter. Therefore, the '420 reference fails to disclose a non-emulsion gel and, Applicants request that this rejection be withdrawn.

The '420 reference fails to teach the non-emulsion gel of the present invention containing substantially no oil. Under 35 U.S.C. §103, a case of *prima facie* obviousness requires, *inter alia*, that prior art references when combined teach or suggest the claimed subject matter to one of ordinary skill in

the art. *In re Vaack*, 20 USPQ2d 1438, 1442 (CAFC 1991); *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). As the amounts of oil in the '420 compositions are greater than 5 percent, the '420 reference fails to teach or suggest the non-emulsion gels of the present invention. The ability to maintain a non-emulsion decreases as the amount of oil increases. Therefore, one of ordinary skill in the art would understand that the '420 reference fails to teach or suggest the non-emulsion gel containing substantially no oil, and thus, that the '420 reference fails to teach or suggest the present invention. This has not been addressed by the Examiner.

In addition, the Examiner finds the present invention obvious in view of the '420 reference or the '049 reference in combination with U.S. Patent No. 5,424,070 ("the '070 reference"). Claims 3, 18, and 23 of the present invention describe a fatty acid that is particularly behenic acid or an alkali metal salt of behenic acid (e.g., sodium behenate). The '070 reference teaches transparent clear stick compositions and fails to remedy any of the defects in the '420 and the '049 references, and in particular, fails to motivate one of ordinary skill in the art to substitute the fatty acid soaps of the '420 and '049 references with those taught in the '070 reference because the transparent clear stick of the '070 reference is unlike the '420 and the '049 compositions. The qualities and capabilities of a fatty acid soap as a gelling agent for a stick product is quite different than the presence of a fatty acid soap in the compositions of the '420 and the '049 references as an emulsifier. For example, the disclosure of fatty acid soaps in the '420 reference at column 6, lines 25 to 31, are to enhance the blending of ingredients, and not as the '420 gelling agent.

Similarly, the '049 reference fails to teach or suggest stick compositions, and therefore, one of ordinary skill in the art would not expect reasonable success making the '049 compositions with the gelling agent of the '070 reference. Further, as previously explained, the '070 reference does not teach that any fatty acid soap is equivalent or substitutable, especially when making different types of products, i.e., a gel versus a stick. The Examiner has failed to provide the source of this alleged disclosure. The compositions of the present invention are non-emulsion gel composition. They are semi-solid or soft gel compositions comprising an aliphatic polyhydric alcohol, an alkali salt of a fatty acid ester, a carbohydrate-based or sterol-based surfactant/emulsifier or combination thereof, water and substantially no oil. The compositions taught in the '420 and the '049 references are unlike that of the '070 reference, therefore, unless one was making a stick product, there is no motivation for one of ordinary skill in the art to make the combination asserted by the Examiner. And, even if one were making a stick product and made the substitution suggested by the Examiner, one of ordinary skill in the art would not expect to

produce the present compositions. As presented above, the '420 reference, alone or in combination with the '070 reference, fails to teach or suggest the present invention, and Applicants request that any §103 rejection be withdrawn.

The cited references fail to teach or suggest the present invention because neither the '420 nor the '049 reference alone, or in combination with the '070 reference, teaches or suggests the components of the present invention, and specifically, the non-emulsion gel with substantially no oil. Therefore, Applicants believe that the §103 rejections should be withdrawn.

CONCLUSION

Applicants believe, based on the remarks provided above in the present submission, that the present claims are in condition for allowance, and therefore, a Notice of Allowance for the present claims is respectfully solicited.

Respectfully submitted,

Date: July 1, 2002



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